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HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

EXAMINER

LE, KHANH H

ART UNIT

PAPER NUMBER

3688

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/030,727

Applicant(s)

WYNNE, ADAM JOSHUA

Examiner

KHANH H. LE

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/12/2008 has been entered. Claims 1-16, 19-22 were and are still pending. No amendment was made to the claims. Claims 1 (method) and 11(system) are independent.

Oath/Declaration

2. It has been agreed a Supplemental Declaration is to be submitted when a Notice of Allowance is issued. As a reminder, the objection to the oath is maintained.

Claim interpretation

3. Claim 11 (system claim):

Applicant appears to invoke 35 USC §112-6th paragraph by (1) utilizing the phrase "means for", (2) modified by functional language, (3) without an indication of sufficient structure, materials, or acts, in the claim, to achieve those functions. In this vein, claims would ordinarily be construed to cover the corresponding structure, material or acts disclosed in the specification and equivalents thereof.

Thus, in claim 11, the claim elements "*searching means for searching..*" and "*combining means for combining...*" are herein construed as means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. This is so because "*searching means for searching..*" is deemed just equivalent to "*means for searching*" since the first "*searching*" is just redundant. Likewise for "*combining means for combining...*".

Here, for the claim elements “*searching means for searching..*” and “*combining means for combining...*”, it is interpreted the written description clearly links or associates the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. (This duty to clearly link or associate structure to function is the quid pro quo for the convenience of employing 112, paragraph 6. If no definition (e.g. link) is provided, some judgment must be exercised in determining the scope of the limitation. (see MPEP 2182)).

It is interpreted these 2 means are software (the software is described at specification at page 6 line 8 and p. 7 line 13 for “searching”; specification at page 4 lines 3-4 (“combining function”) and p. 7 line 13), downloaded onto user computer or on some “package” to be installed on user computer (p. 7 last paragraph) thus the combination of the software and the user computer used to perform the functions of searching and combining on the user computer is considered a structural element satisfying 35 USC §112-6th paragraph) wherein the software algorithm is described in sufficient requisite details (see specification p. 5 lines 8-17) to pass the written description and enablement tests under 35 U.S.C. 112, 1st paragraph.

Note 1: If Applicant does not want to invoke 112, paragraph 6, for these 2 limitations, Applicant must state so clearly on the record and avoid (1) utilizing the phrase “means for”, (2) modified by functional language, (3) without an indication of sufficient structure, materials, or acts, in the claim, to achieve those functions.

Note 2: The Examiner further notes that if Applicant does not want to invoke 112, paragraph 6, for these 2 limitations, and claim 11 may read on software only (because the specification at page 6 line 8 and p. 7 line 13 arguably shows the “searching means for searching..” to be software only. Likewise for the “combining means for combining...” at specification at page 4 line 3-4 (“combining function”) and p. 7 line 13), **claim 11 as a whole may be found directed to non-statutory subject matter under 35 USC § 101 because directed to software per se. See MPEP 2106.01(I). The database is just a collection of data. The comparator and operator means are only mentioned once at page 4 line 14 and in claim 11 without further details except for “comparing” in claim 1, thus also appears to involve software**

only. Thus claim 11 as a whole may be found directed to software per se. Claims 12-16, and 21-22 would be found to suffer from the same defect.

As to “comparator and operator means for ...”, it is interpreted the clause does not invoke 35 U.S.C. 112, sixth paragraph. (See discussion under the second paragraph of 35 U.S.C. 112 below). Thus the Examiner will interpret the “comparator and operator means for ...” limitation as reading on any prior art means which is capable of performing the specified functions under a broadest reasonable interpretation.

Claim Rejections - 35 USC § 101

4a. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4b. Claims 1-10, and 19-20 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.

Claim 1:

Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter.

Further, recently, the Court of Appeals for the Federal Circuit issued an opinion affirming a final decision by the Board of Patent Appeals and Interferences sustaining a rejection of claims because they were not directed to patent-eligible subject matter under 35 U.S.C. 5 101. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). The court's opinion clarified the standards applicable in determining whether a claimed method constitutes a statutory "process" under Section 101. Under *Bilski*, a method claim must meet a specialized, limited meaning to qualify as a patent-eligible process claim. As clarified in *Bilski*, the "machine-or-transformation test" for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. Thus, there are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, the method of claim 1 is not tied to another statutory category except for the nominal step a) of searching the hard disk step which is deemed a mere data gathering step. Steps b), c), d), and e) of combining, comparing, accessing, storing and recording are not claimed as using a computer.

Thus claim 1 fails to meet the above requirements of *Bilski*.

(See similar analysis in Informative Board of Patent Appeals and Interferences decision, *Ex Parte Langemyr*, (a pre-*Bilski* decision) at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf>, (see rationale starting at page 20)).

Nor does claim 1 claim to physically transform underlying subject matter (such as an article or materials) to a different state or thing. Thus claim 1 is deemed directed to non-statutory subject matter. This rejection may be overcome by claiming "by a computer" after the main inventive steps of "combining", "comparing", "accessing", "storing and recording" in steps b), c), d), and e).

Claims 2-10, and 19-20 suffer from the same defect.

Claim Rejections - 35 USC § 112

5a. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5b. Claims 11-16 and 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5c. Note: This rejection under 35 U.S.C. 112, 2nd Paragraph is because it is unclear Whether Claim Limitation is Invoking 35 U.S.C. 112, Sixth Paragraph, the Phrase "Means for" or "Step for" by themselves not being used.

Claim 11: It is unclear whether the claim element "comparator and operator means for ..." is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph, because a comparator and an operator may be sufficient structures to negate the invocation of 35 U.S.C. 112, sixth paragraph.

Claims 12-16 and 21-22 are rejected as being dependent upon rejected base claim 11.

Note: If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to:

(a) Amend the claim to include the phrase "means for" or "step for" in accordance with these guidelines: the clause "means for" or "step for" must be modified by functional language and the clause must **not** be modified by sufficient structure, material, or acts for performing the claimed function; or

(b) Show that the claim limitation is written as a function to be performed and the claim does **not** recite sufficient structure, material, or acts for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph. For more information, see MPEP 2181.

Here, it is interpreted the clause "comparator and operator means for ..." does not invoke 35 U.S.C. 112, sixth paragraph. The Examiner will interpret the "comparator and operator means for ..." limitation as reading on any prior art means which is capable of performing the specified functions under a broadest reasonable interpretation.

Claim Rejections - 35 USC § 112-1st paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 1-16, 19-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey**

to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1: Specification at page 6, line 23 to page 7, line 3 (cited by Applicant) does not support repeating step

“(c) if the unique identifier is not present in the store, then storing it in the store and recording against it data associated with that computer”; as claimed in step f)

“(f) repeating steps (a) through (e) each time the computer connects on-line to the remote site”.

Claim 11 is interpreted as reciting similar limitation in means format and is rejected on the same basis.

Claims 2-10, 12-16, 19-22 are rejected as being dependent upon rejected base claims 1 and 11.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-9, 11-16, 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregg et al., US 6516416 B2 in view of PENKAVA et al, WO 95 35533 A.

Claims 1-16, 19-22:

Gregg discloses accessing a remote site to access service such as intellectual property and reauthentication of the accessing user computer before service is rendered to prevent unauthorized use (abstract; col. 5 lines 33-55; Figures 13, 17, 20, 28 and associated text; e.g. col. 12 lines 23-40; col. 18 lines 13-17; col. 2 lines 1-8 : database for tracking, storing and updating transaction history). New users data are tracked and recorded (see e.g. col. 14 lines 4-21).

Gregg teaches uniquely identifying the user and the computer before each new session by encrypting a unique identifier. The identifier can be derived from a two factor authentication process partly using unique identifiers associated with the computer hardware (e.g. using a uniquely identified “hardware access key”, col. 1 lines 58-67; col. 7 lines 59-65; col. 21 line 37 to col. 22 line 45; Fig 28). The unique identifier is recreated at each reauthentication instance which can be a log-on instance. The combining of user identifier and computer identifier is done on the user computer and sent to the remote server at each reauthentication (see e.g. col. 13 lines 56-63).

Gregg does not specifically disclose the unique identifier is made up of a unique identifying element from the hard disk combined with other information associated with hardware of the computer.

However, PENKAVA, in a scheme to protect software use, discloses that a computer can be uniquely identified with a “validation number “, obtained by combining as desired various unchanging identifying elements inherent to the computer, to achieve the desired uniqueness p. 15 l. 33- p. 16 l.22) , such as combining its serial number with Bios data (p. 16 l. 20-22). Other combinable elements include disks sectors or cylinders (p. 16 l. 20-22). Searching the hard disk for such identifying elements before combining is taught in PENKAVA (page 14, lines 4-6; e.g. a serial number: page 16 lines 3-22).

Thus it would have been obvious to one having ordinary skill in the art at the time of the invention (herein a "PHOSITA"), to replace the unique identifier of Gregg with that taught by PENKAVA to uniquely identify the user computer to allow access to online services as taught by Gregg. A Phosita would have wanted to use the identifier taught by PENKAVA if only the computer needs to be identified (as taught by Penkava) and not the user, individually, as done in Gregg. Identifying the computer alone would have been sufficient if a higher level of security is not needed yet it is desired to prevent use fraud by using the unchanging identifying elements inherent to the computer as taught by Penkava.

(Note: Other relevant teachings of PENKAVA also discloses the unique identifier is sent to the remote site, from where it is compared to the store (e.g. Figure 4 item 60; page 12 lines 2-4; page 32 lines 13-17); PENKAVA also discloses combining the computer identifier can be done with other identifiers on the computer if needed (page 16, line 31 et seq.) and is an encryption process (Figure 2 item 42, page 11 lines 17-18) done to obtain the level of uniqueness or security desired (page 16, lines 15-17).

Note:

a) As to "the data relating, at least partially, to a credit record of previous transactions effected from that computer", (claims 1 and 11) **such data is non-functional descriptive material because no steps are performed on the particular data.**

The Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). In re Gulack, 703 F.2d 138 1, 1385,217 USPQ 401,404 (Fed. Cir. 1983) *(when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).*

When the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and can not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

In this instance, none of the structure or functionality found in the limitations of claim 1 is due to the information recited. That is the particular information neither enhances nor diminishes the structure and functionality of the underlying database. Here the “structure or functionality” refers to the recited database, computer and remote site and to the storing and accessing of data steps. The pieces of information received into the database are only a compilation of data, that coincides with the definition of non-functional descriptive material in MPEP 2106.

See also the following USPTO Board of Appeals and Interferences Informative Decisions for similar analyses:

Ex parte James Prescott Curry,
<http://www.uspto.gov/web/offices/dcom/bpai/its/fd050509.pdf>

Ex Parte Herman Mathias,
<http://www.uspto.gov/web/offices/dcom/bpai/its/fd051851.pdf>, (affirming a 35 USC section 102 rejection) (also affirmed at the CAFC (August 17, 2006)).

b) data associated to the user computer, and against which the unique identifier is recorded, relates to further data associated with such previous transactions (claims 2, 12) is **non-functional descriptive material**, and is not given patentable weight. In re Gulack, 703 F.2d 138 1, 1385,217 USPQ 401,404 (Fed. Cir. 1983) (*when descriptive material is not functionally*

related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

c) further data comprises credit card details used during such previous transactions (claims 19 and 21 dependent on claims 2, 12) is **non-functional descriptive material**, and is not given patentable weight. In re Gulack, 703 F.2d 138 1, 1385,217 USPQ 401,404 (Fed. Cir. 1983) (*when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability*).

10. **Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gregg in view of PENKAVA as applied to claim 9 above, and further in view of Official Notice.**

Claim 10:

Gregg and PENKAVA disclose a method as in claim 9 above and both disclose encryption and authentication processes characteristics (e.g. Penkava at page 16 line 31-page 19 line 23; Figures 6, 16) using the user unique hardware to ensure correct identification of the user computer (e.g. Penkava, page 19 lines 10-23). However, neither specifically discloses a 'hash-type' encryption and authentication process.

However hash type encryption is a common encryption and authentication method and has been known to be a substitute for checksum encryption and authentication (see e.g. Elliott, US 6468160 B2, col. 33 lines 36-39). Thus, it would have been obvious to a Phosita to substitute such hash type method to Gregg and PENKAVA encryption teaching as an alternate encryption

and authentication method, to achieve the desired and predictable result of properly securing data.

Response to Arguments

11. Applicant's arguments have been fully considered but they are not persuasive. The above new grounds of rejection address the amended claims.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHANH H. LE whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314)..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 2, 2009

/Khanh H. Le/

Examiner, Art Unit 3688